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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,586

12/22/2003

Martin Kleen

P03,0576

7984

26574

7590

07/22/2008

SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/743,586	Applicant(s) KLEEN ET AL.	
	Examiner VALERIE LUBIN	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>EAST search history</u> . |

DETAILED ACTION

Acknowledgements

1. Claims 1-26 are pending

For reference purposes, the document paper number is 20080717

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao U.S. Pre-Grant Pub No. 2001/0032099 in view of Graettinger U.S. Patent No. 5,839,438.

4. With respect to claim 1, Joao recites entering input data into a computer (§ 213); and determining an expected output data (§ 215) and making said output data available to the user (§ 216).

With respect to types of data sets or medical data (e.g. patient data, procedure success rate and duration), they are mere non-functional descriptive material that do not further limit the method steps of claim 1 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re

Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Furthermore, Joao recites such data (§ 152, 220).

Joao does not specifically recite creating a decision tool using data sets; however, Graettinger does (Abstract; col. 3 lines 5-11). It would have been obvious to one of ordinary skill in the art to combine the teachings of Joao with those of Graettinger in order to provide patients with reliable information with respect to medical or health related issues.

Claims 15 and 21 are rejected under the analysis of claim 1.

5. Regarding claims 2-4, Joao and Graettinger recite using their invention to provide diagnosis or/and treatment information (Abstract). A predictable result of Joao and Graettinger would therefore be to include data sets for any medical procedure pertaining to a provider's area(s) of expertise (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

6. For claims 5 and 6, Graettinger recites data sets (Col. 7 lines 47-52). A predictable result of Graettinger would have been to include as many data sets as possible in order to increase the reliability of the output data (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

7. Claim 7 is rejected, as Graettinger recites a neural network (Abstract).

8. For claim 8, verifying decision tool or expert systems is old and well known in the art.

Claims 16 and 22 rejected under the analysis of claim 8.

9. With respect to claim 9, charging fees to access information using a computer network is old and well known in the art.

Claims 12, 13, 18, 19, 24 and 25 are rejected under the analysis of claim 9 as they are all predictable results of charging a fee (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

10. Claim 10 is rejected, as Joao and Graettinger recite making their inventions available on the worldwide web (Joao, ¶ 21; Graettinger, Col. 5 lines 15-18).

11. With respect to claim 11, Joao recites making output data available to a computer (¶ 216) and revising data (¶ 306, 307).

Joao does not specifically recite buffering input data, but to buffer data is old and well known in the art.

Claims 17 and 23 are rejected under the analysis of claim 11.

12. As for claim 14, Joao recites making output data available to a computer (¶ 216) and revising data (¶ 306, 307).

Joao does not specifically recite buffering input data and reducing a fee when a user makes data available to a computer, but to buffer data and to apply a fee based on information accessed or obtained is old and well known in the art.

Claims 20 and 26 are rejected under the analysis of claim 14.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Murphy et al., U.S Patent No. 5,077,677 discloses verifying an expert system.

b) Teller et al.; U.S. Patent No. 6,605,038 and Felsher U.S. Pre-Grant Pub No. 2002/0010679 disclose charging fees for accessing information through a computer network and Teller discloses buffering data.

c) Brunner et al., U.S Pre-Grant Pub No. 2003/0004652 recites buffering input data.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626